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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,047	02/04/2002	James J. Kobe	57147US002	4924

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE - 3 - MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-21 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-21 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-21 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, the multiple criteria set forth in applicants' specification at page 7 line 20 - page 8 line 2 appear to be performance parameters that are each critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kreckel et al. in view of Joseph et al. The primary reference discloses (note particularly Figures 1A-1C, column 2 lines 30-43, column 3 line 36 - column 4 line 12, and particularly claims 19 and 17) in the embodiment of claim 19 substantially an anticipation of at least applicants' broad independent claim 1 except for the notable absence of the presence of a fibrous reinforcing material which also imparts stretch release properties. However, the reference, which is primarily directed at stretch release adhesive tapes having a significant amount of elasticity in their tape backing clearly teaches the presence of a polymeric foam material (e.g., a backing) having adhesive properties on the outer surface(s) thereof. The secondary reference Joseph et al. discloses (note particularly column 10 line 58 - column 11 line 33, particularly column 11 lines 4-13, as well as column 5 lines 54-66, column 7 lines 17-40, and column 9 lines 6-23) a broad genus of non-woven webs made from a variety of fibers which can include such fibers as reinforcing or elastic threads or strands (column 11 lines 4-6) that can be used in stretch release adhesive tape backings and the like so as to form a highly extensible foam material or backing wherein the elastic behavior of the web can be controlled to an appropriate level, depending upon the application (column 9 lines 11-13). Accordingly, one of ordinary skill, motivated by

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the expectation of improved elastic properties in his genus of foam adhesive articles desirous of improving their stretch release properties, would have more than ample motivation to look to the teachings of Joseph et al. and incorporate the elastic fibers disclosed therein, and thereby form the claimed genus of articles. Additionally, with respect to the method claims 16-20, as well as several of the dependent article claims, these are believed to employ well known elements and methods of preparing a foamed adhesive article. In support of this, the Examiner cites Gehlsen et al., quoted extensively in applicants' specification, as evidence of the state of the art (note particularly Figures 3-5, column 1 lines 45-67, column 2 lines 18-27, column 3 line 4 - column 4 line 14, column 6 line 18 - column 7 line 52 and column 8 line 65 - column 9 line 15). The reference clearly teaches applicants' claimed method, minus the absence of forming the fibers, and also further discloses such elements as the presence of expandable polymeric microspheres (applicants' claim 12), and clearly discloses that a great number of the aforementioned foam limitations and process steps are well within the ordinary skill of the art. Other parameters that have not been either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

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5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Joseph, Bries et al., and U.S. Patent Application Publication 2002/0132115A1 to Hamerski et al.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

March 6, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zirker*